

REMARKS

Consideration and entry of this paper, and reconsideration and withdrawal of any and all objections to and rejections of the application, and allowance of the claims, especially in view of the amendments and remarks made herein, are respectfully requested, as this paper places the application in condition for allowance, or in better condition for appeal.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 2 and 12 are pending. By this paper claims 3, and 12 are amended, and claims 1, 2, 4, 5, 7-11, and 14-16 are cancelled, without prejudice. Applicants expressly reserve the right to pursue cancelled subject matter in a continuing application.

No new matter is added by this amendment.

It is submitted that these claims are patentably distinct from the prior art cited by the Examiner, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments and remarks herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather the amendments and remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled. Support for the amended recitations in the claims is found throughout the specification.

II. 35 U.S.C. §112, FIRST PARAGRAPH, REJECTION

In points three and four of the Office Action, claims 1-2, 4-5, 7-11, and 14-16 were rejected under 35 U.S.C. §112, first paragraph for allegedly failing to comply with the written description requirement. Applicants disagree with these rejections. However, in order to advance the prosecution of the present application these claims are hereby cancelled, thus rendering these rejections moot.

In point four of the Final Office Action, claim 12 was also rejected under 35 U.S.C. §112, first paragraph for allegedly failing to comply with the written description requirement. This rejection is respectfully traversed.

Claim 12 is drawn to methods of distinguishing *L. monocytogenes* using one of the nucleic acid molecules of claim 3. The Final Office Action alleges that claim 3 encompasses fragments from within the recited SEQ ID NOs, which are not taught in the specification, such as for example, 3mers and 10mers. The Office Action goes on to conclude that the specification therefore does not allow a person of ordinary skill in the art to recognize that the Applicant invented that which is claimed. However, it appears that the Examiner has misunderstood

Applicants intended meaning of claim 3. Contrary to the assertions of the Final Office Action, claim 3 was not intended to encompass fragments from within the recited SEQ ID NOs. Instead claim 3 was intended to encompass the sequences of SEQ ID NOs 1-7, and those sequences complementary to SEQ ID NOs 1-7. Thus, by virtue of its dependency on claim 3, claim 12 was also intended to encompass the sequences of SEQ ID Nos 1-7, or the sequences complementary thereto, and not any fragments of these sequences. Applicants believe that the meaning of the claim as previously presented was quite clear. However, for the sake of clarity claim 3 is hereby amended to more clearly recite isolated nucleic acid molecules of SEQ ID Nos 1-7, or the sequences complementary thereto. Consequently, reconsideration and withdrawal of the rejection of claim 12 under 35 U.S.C. §112, first paragraph, is respectfully requested.

III. 35 U.S.C. § 112, SECOND PARAGRAPH, REJECTION

In point five of the Final Office Action, claims 1-5, 7-12, and 14-16 were rejected under 35 U.S.C. §112, second paragraph for allegedly being indefinite for failing to point out and distinctly claim the subject matter which the Applicant regards as the invention. Applicants respectfully disagree.

The cancellation of claims 1-2, 4-5, 7-11 and 14-16, however, renders moot the rejection of these specific claims. In addition, in light of the amendments and remarks presented herein, the rejection of claims 3 and 12 under this section are overcome.

The Office Action alleges that it is unclear whether the recitation of “an isolated nucleic acid molecule of” in claim 3 is intended to encompass only a nucleic acid consisting of these sequences, or whether the claim is intended to encompass fragments from within these sequences. As described above, Applicants believe that the meaning of the claim as previously presented was quite clear. However, for the sake of clarity claim 3 is hereby amended to more clearly recite isolated nucleic acid molecules consisting of SEQ ID Nos 1-7, or the sequences complementary thereto. By this amendment the rejection of claim 3 under 35 U.S.C. §112, second paragraph is overcome.

The Office Action further alleges that in claim 12 it is unclear how the step of “distinguishing” comes about from merely “providing a nucleic acid” and states that it is unclear if the nucleic acid supplied in the “providing” step is being detected, or if the nucleic acid is used in next step of detecting or distinguishing. The Office Action also alleges that it is unclear how the “distinguishing” between *Listeria monocytogenes* and bacteria of other species

is performed. Specifically, the Examiner questions whether one needs to compare a sequence from *Listeria monocytogenes* with a DNA sequence of another species in order to perform the “distinguishing”. By this paper claim 12 is amended to more clearly define the steps of the claimed method. Support for the additional steps recited in amended claim 12 is found in the specification from page 6, line 35, to page 8, line 13, and also in Examples 1 and 2. By the amendment to claim 12 presented herein the rejection of this claim under 35 U.S.C. §112 is overcome.

It should be noted that, although a comparison between the DNA sequence of *Listeria monocytogenes* and that of other bacterial species can be performed using the method of amended claim 12, it is not necessary to perform such a comparison in order to achieve specific detection of *L. monocytogenes*. Similarly, although negative control samples from other bacterial species can be used to verify the specificity of the detection of *L. monocytogenes* achieved using the method of claim 12, this is not essential. Instead, uniquely specific detection of *L. monocytogenes* can be achieved using the method of amended claim 12 alone. This is because, surprisingly and unexpectedly, probes consisting of SEQ ID Nos 1-7 bind to a genomic region that is conserved between all strains of *L. monocytogenes*, but is divergent in the genome of other bacterial species. Thus, primers and/or probes consisting of SEQ ID Nos 1-7 enable specific and unequivocal detection of all *L. monocytogenes* strains without unwanted cross-reactivity with DNA of other bacterial species.

IV. 35 U.S.C. § 102 REJECTIONS

Claims 1, 4, 5, 7, 9, 10, 14 and 15 were rejected under 35 U.S.C. §102(b) as being anticipated by Domann et al. Applicants respectfully disagree with this rejection. However, by the cancellation of claims 1, 4, 5, 7, 9, 10, 14 and 15 this rejection is rendered moot.

Claims 1, 2, 4, and 5 were rejected under 35 U.S.C. §102(b) as being anticipated by EST accession number AA207653. Applicants respectfully disagree with this rejection. However, by the cancellation of claims 1, 2, 4, and 5 this rejection is also rendered moot.

Claim 3 was rejected under 35 U.S.C. §102(b) as being anticipated by Brennan et al. which allegedly teaches an array of isolated trimers. In accordance with the Examiner’s suggestion, claim 3 has been amended to recite “an isolated nucleic acid molecule from the group consisting of a) SEQ ID NO:1...”. Amended claim 3 does not encompass fragments such as trimers, thus the rejection of this claim under 35 U.S.C. §102(b) is overcome.

V. 35 U.S.C. § 103 REJECTIONS

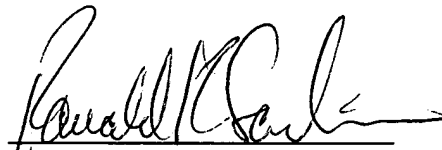
Claims 2, 3, 9, 11 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Domann et al in view of Rosen et al. Applicants respectfully disagree. However, the cancellation of claims 2, 9, and 11, renders moot the rejection of these specific claims.

The rejection of claims 3 and 12 under 35 U.S.C. §103(a) is traversed. The Office Action states, on the final paragraph of page 11, that the rejections under 35 U.S.C. §103(a) do not apply to sequences consisting of the specific sequences of SEQ ID Nos 1-7. Previously presented claims 3 and 12 were intended to encompass sequences consisting of the specific sequences of SEQ ID Nos 1-7, and not fragments of those sequences. However, for the sake of clarity, claim 3 is hereby amended to more clearly recite isolated nucleic acid molecules consisting of SEQ ID Nos 1-7, or the sequences complementary thereto. Consequently, reconsideration and withdrawal of the rejections of claims 3 and 12 under 35 U.S.C. §103(a) is warranted and is respectfully requested.

CONCLUSION

In view of the amendments and remarks herewith, which are fully responsive to the rejections, the application is in condition for allowance or in better condition for appeal. Consideration and entry of this paper, favorable reconsideration of the application and reconsideration and withdrawal of the objections to and rejections of the application, and prompt issuance of a Notice of Allowance are earnestly solicited.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: 
Ronald R. Santucci
Reg. No. 28,988
(212) 588-0800